

Pre-judgment seizures:  
*Anton Piller, Mareva,*  
*Norwich Pharmacal*  
Gwilym Harbottle

H|C

# *Anton Piller v Manufacturing Processes* [1976] Ch. 55



# The *Anton Piller* (aka seizure) order

An order that the respondent:

- permit the applicant to enter premises and inspect allegedly infringing articles and documents
- hand over allegedly infringing articles and documents to the applicant
- disclose sources

“one of the law's two “nuclear” weapons”

Donaldson J in *Bank Mellat v Nikpour* [1985]  
FSR 87

# Legal basis

- *Entick v Carrington* (1765) 2 Wilson, K.B. 275: court has no power to issue a search warrant
- *E. India Coy v Kynaston* (1821) 3 Bli. (O.S.) 153: order to permit is different
- 1974: orders obtained by Hugh Laddie against pirate tape sellers, culminating in *EMI v Pandit* [1975] 1 WLR 302 and *EMI v Sarwar* [1977] FSR 146 (disclosure of sources)
- Jurisdiction confirmed in *Anton Piller* itself
- 1982: revocation of self-incrimination privilege in IP
- See also TRIPS Art. 50; IPRED Art. 7, Civil Procedure Act 1997

# The jurisdiction reined in

- *Columbia v Robinson* [1987] Ch 38: entails serious inroads on presumption of innocence, right not to be condemned unheard, protection against arbitrary searches and seizures and sanctity of the home. Non-disclosure, seizures outside scope of order and loss of articles resulted in aggravated damages on the cross-undertaking
- *Universal Thermosensors v Hibben* [1992] 1 WLR 940: need for supervising solicitor and female in attendance

# Practice

- ex parte (so full disclosure duty)
- extremely strong prima facie case and real possibility of destruction of evidence or infringing articles
- combine with: disclosure order, interim injunction, *Mareva*
- supervising solicitor
- cross-undertaking as to damages

# Practicalities in copyright cases

- duty of full disclosure extends to weaknesses in chain of title, possible implied licences, possible exceptions
- experienced supervising solicitor critical
- execution and aftermath very resource-intensive identification, inspection and storage of material
- risk expense will dwarf the remedy

*Mareva v International Bulkcarriers  
Ltd* [1975] 2 Lloyd's Rep. 259





# The *Mareva* (aka freezing) injunction

“an order, usually an ex parte order, preventing a defendant against whom a plaintiff has a pending or anticipated proceeding from disposing of assets before the trial with a view to depriving the plaintiff of the benefits of any judgment”

Heydon et al. *Meagher, Gummow & Lehane's Equity Doctrines and Remedies* (5th edn) [21-430]

... the law's other “nuclear weapon”

# The 19<sup>th</sup> Century

- *Lister v Stubbs* 45 Ch D 1 at 13: “I know of no case where, because it was highly probable that if the action were brought to a hearing the plaintiff could establish that a debt was due to him from the defendant, the defendant has been ordered to give security until that has been established”
- s. 25(8) Judicature Act 1873 – injunction “may be granted ...in all cases in which it shall appear to the Court to be just or convenient”

# The rise ...

- *Nippon v Karageorgis* [1975] 1 WLR 1093; *Mareva* (1975): injunction can be granted whenever there is a legal or equitable right (but see now *Fourie v Le Roux* [2007] UKHL 1)
- *Rasu v Pertamina* [1978] QB 644: good arguable case enough
- *Rahman v Abu-Taha* [1980] 1 WLR 259: can restrain dissipation within as well as removal from jurisdiction
- *Barclay-Johnson v Yuill* [1980] 3 All ER 190: applies to UK residents too

## ... and rise

- 1982: recognized in the UK by statute which sanctions “free-standing” order in support of EU claims (since 1997 claims anywhere)
- 1982: property of the respondent in hands of a third party: *Galaxia* [1982] 1 WLR 539
- 1990: assets worldwide: *Babanaft v Bassatne* [1990] Ch 13
- 2001: property of a third party which could be taken in execution e.g. by a receiver: *C Inc v L* [2001] CLC 1054
- See also Art. 9(2) IPRED

# Practice

- ex parte and cross-undertaking as to damages
- good arguable case and real risk judgment will go unsatisfied
- in personam, not proprietary and usually no freezing of specific assets
- exclusions permitting payments in ordinary course, living expenses, legal expenses
- ancillary orders: disclosure of assets, search orders, restraining D from leaving jurisdiction and even delivery up: *CBS v Lambert* [1983] Ch. 37

# Considerations in copyright cases

- duty of full disclosure (as *Anton Piller*)
- quantification of financial claims may be difficult at outset of a case
- risk of satellite litigation about disclosure
- seek interim injunction/delivery up/*Norwich Pharmacal* at the same time

*Norwich Pharmacal v Customs  
& Excise* [1974] AC 133



# Origins/legal basis

- *Plummer v. May* (1750) 1 Ves.Sen. 426: bill of discovery not available against a “mere witness” (innocent bystander)
- *Upmann v Elkan* (1871) L.R. 12 Eq. 140: innocent freight forwarder of counterfeit cigars had a duty to give “all the information required”, not remove or deal with the goods and give “all facilities” to claimant. Rationale: protect the mark
- *Orr v Diaper* (1876) 4 Ch. D. 92: innocent carrier of counterfeit thread ordered to disclose name of shipper
- *Norwich*: Customs ordered to disclose identity of importers of patent infringing goods. Not a mere witness (there would be no action without the order/facilitated)
- See also TRIPS Art. 47 (infringer only); Art. 8 IPRED



# Rationale

- *Norwich Pharmacal*: innocent facilitator of a tort under a duty to assist person wronged by giving full information and disclosing identity of wrongdoers
- *MGH* at [21-015]: “an equitable duty”
- But see *Cartier* [2018] UKSC 28 at [11]: references to duty are just another way of saying that the court has a discretion to intervene

# Conditions

- Arguable wrong
- Need to take action (legal or otherwise) against wrongdoer
- R is likely to provide the information and is mixed up (innocently or otherwise)
- It would be proportionate to order disclosure despite any interference with the rights of the respondent or third parties: *RFU* [2012] UKSC 55
- Applicant to pay innocent respondent's costs of application and compliance (NB – blank cheque but may recover from infringer: *Morton Norwich Intercen* [1981] FSR 337)

# Copyright respondents

- sellers of infringing material: identity of suppliers and wholesale purchasers
- those who host infringing online material: identity of site operators or those who post
- banks: identity of account holders and relevant transactions
- police: details of investigations/ seized material